

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 15-31 were pending in this application when last examined and stand rejected.

Claims 17-21, 26-28, 30 and 31 were withdrawn as non-elected subject matter.

Claims 15, 16, 22-25 and 29 were examined on the merits and stand rejected.

Claims 15 and 16 were objected to.

Claims 15-18 are amended in a non-narrowing manner to replace "No." with "NO:" in the sequence identifiers as suggested by the Examiner.

Claims 15, 26, and 30 have been amended to remove the terms "selective" and the "variants" language. Support can be found in the claims as filed.

New claim 32 has been added. Support can be found in the disclosure at page 5, lines 13-15.

No new matter has been added.

The specification has been revised as page 12, lines 12-16 to correct an inadvertent error by removing reference to "panel".

The specification has been revised to use the correct references for the noted trademarks as suggested by the Examiner and to correct typographical errors. The specification has also been revised to correct the title and the abstract.

A new Abstract has been submitted to replace the old Abstract. The new Abstract better reflects the subject matter of claim 1 as suggested by the Examiner.

The title has been revised along the lines suggested by the Examiner.

No new matter has been added.

Applicant is submitting the present Amendment without prejudice to the subsequent prosecution of claims to some or all of the subject matter which might be disclaimed by virtue of this response (although none is believed to be), and explicitly reserves the right to pursue some or all of such subject matter, in Divisional or Continuation Applications.

Applicant thanks the Examiner for the careful examination of this case and respectfully requests reexamination and reconsideration of the case, as amended. Below Applicant addresses the rejections in the Office Action and explains why the rejections are not applicable to the pending claims as amended.

II. OBJECTIONS TO THE SPECIFICATION

The specification was objected for the reasons set forth in items 2-5 on pages 2-3 of the Office Action.

The present amendment overcomes the concern in item 2 on page 2 by revising the specification at page 12, lines 12-16 to remove reference to "panel".

The present amendment overcomes the concern in item 3 on page 3 by amending the specification to correctly reference trademarks.

Applicants have also revised the Abstract and title to address the concerns in items 4-5.

Thus, withdrawal of the above objection is solicited.

III. CLAIM OBJECTIONS

Claims 15 and 16 were objected to on the basis that the format for the sequence identifier is improper. See item 6 on page 4 of the Office Action.

The present amendment overcomes this objection by amending the claims to use the format for the sequence identifier suggested by the Examiner. Withdrawal of the objection is requested.

IV. INDEFINITENESS REJECTION

Claims 15 and 16 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons in item 7 on pages 4-5 of the Office Action.

For the sole purpose of expediting prosecution and not to acquiesce to the rejection, Applicant has amended the claims to remove the terms "selective" and "variants" thereby obviating this rejection. The claims are thus clear, definite and have full antecedent basis.

This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

V. WRITTEN DESCRIPTION AND ENABLEMENT REJECTIONS

Claims 15, 16, 22-25, and 29 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for the reasons set forth in item 8 on pages 5-7 of the Office Action.

Claims 1-22 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement for the reasons set forth in item 9 on pages 7-10 of the Office Action.

These rejections are respectfully traversed.

It is noted that the grounds for the two rejections are essentially the same. In particular, the Office is concerned about the breadth of the "variants" and asserts that such

language renders the claims overly broad. For the sole purpose of expediting prosecution and not to acquiesce to the rejection, Applicant has amended the claims to remove the "variants" language thereby obviating this rejection.

Nonetheless, Applicants have added new claim 32 that recites "the promoter having at least 95% sequence identity to SEQ ID NO: 1 and that has promoter activity." Applicants respectfully submit that the specification provides full written description and enabling support for this claim.

The Examiner contends that the specification does not disclose any "variants" of SEQ ID NO: 1 other than fragments of SEQ ID NO: 1 that have promoter activity. The Examiner argues that the specification does not disclose nucleic acids having 80, 85, or 90% identity to SEQ ID NO: 1.

In reply, it is noted that the test for sufficiency of written description is whether the disclosure reasonably conveys to the artisan that the inventor had possession at the time of filing of the subject matter which is claimed. M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2163, I, 2100-159, 1st column, 2nd paragraph. This test may be satisfied by: (1) a reduction to practice; (2) a reduction to drawings/chemical formulas; (3) a disclosure of relevant identifying characteristics, such as structure or other physical and/or chemical properties, to sufficiently describe the claimed invention in full, clear, concise and exact terms; (4) a disclosure of functional

characteristics coupled with a known or disclosed correlation between function and structure; (5) a sufficient description of a representative number of species; or (6) a combination of the above, sufficient to show the inventors were in possession of the invention. M.P.E.P. (Eighth Ed., Rev. 6 (September 2007) at § 2163, II, A, 3a(i)-(ii).

As noted by the Examiner, the specification clearly discloses the promoter sequence of SEQ ID NO: 1 taken from the *Arabidopsis* MYB60 gene (at page 5, lines 16-18). The specification also discloses fragments of said promoter as SEQ ID NOS: 2, 3, and 4 (page 5, lines 18-20). The specification also discloses the promoter can have at least 95% identity to SEQ ID NO: 1 and retain such activity. Applicant believes that such disclosure constitutes a sufficient description of a representative number of species of the claimed invention.

The specification also describes the various portions of the promoter sequence of SEQ ID NO: 1 from the *Arabidopsis* MYB60 gene that are responsible for the activity of the promoter. See, for instance, the description at page 12, lines 7-9, wherein it is stated that "the entire promoter sequence SEQ ID No. 1, or fragments thereof containing the 246 bp portion upstream of the ATG codon, enable ABA-independent expression of transgenes in stomatal guard cells." See Figure 2 and the description thereof (page 9, lines 16+ to page 11, and page 12, that discuss the various genetic constructs under control of different portions of

the promoter sequence. Applicant submits that such also corresponds to a disclosure of functional characteristics coupled with a known or disclosed correlation between function and structure.

It should be noted that the new claim does recite the functional language of "at least 95% sequence identity to SEQ ID NO: 1 that has promoter activity."

The disclosure of the full length of SEQ ID NO: 1, the fragments thereto, and the regions responsible for activity of the promoter, combined with the pre-existing knowledge in the art regarding the genetic code and its redundancies would have put one of skill in the art in possession of the genus encompassed by the "at least 95% identity" language in the new claim at the time of filing. In other words, based on such disclosure and the knowledge in the art field, those skilled in the art could readily envision all of the nucleotide changes that are 95% identical to SEQ ID NO: 1, and still retain the promoter activity. Based on such, those skilled in the art would reasonably believe that the Applicant was in possession of the subject matter of new claim 32 at the time of filing.

Lastly, it should be noted that the 95% identity scope is currently sanctioned by the USPTO per the current Written Description Guidelines.

Based on such, Applicants believe that the specification provides full written description support for new claim 32.

Turning now to the enablement rejection and new claim 32, the test of enablement is whether one reasonably skilled in the art could make or use the invention based on the disclosure in the specification coupled with the knowledge in the art without undue experimentation. The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2164.01 and *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. In fact, the test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification provides reasonable guidance with respect to the direction in which the experimentation should proceed.

In the instant case, it is respectfully submitted that the disclosure provides sufficient guidance to enable the scope of new claim 32 for basically the same reasons set forth above.

Based on the discussion above, it is respectfully submitted that the skilled artisan, upon reading the disclosure and in view of the knowledge in the art, could construct the limited promoters having "at least 95% identity to SEQ ID NO: 1"

encompassed by new claim 32, and then use the assays disclosed in the specification and known in the art in order to confirm that the said promoters have requisite functional activity (akin to that of SEQ ID NO: 1 of the disclosure) such that they could be used to in the genetic construct for expression of nucleic acids in plants. Moreover, it is believed that such could be done using the routine techniques and procedures disclosed in the specification without undue experimentation. Thus, the present specification is full enabled for new claim 32.

For these reasons, the above written description and enablement rejections should be withdrawn, and they should not be applied to new claim 32.

VI. ANTICIPATION REJECTION

Claims 15, 16, 22-25, and 29 were rejected under 35 U.S.C. § 102(b) as anticipated by TARCYNISKI (U.S. 6,653,535) for the reasons in item 10 on pages 11-12 of the Office Action.

This rejection is respectfully traversed.

The basis for this rejection is that the "variants thereof" language renders the claims overly broad and encompasses the cited prior art teaching. For the sole purpose of expediting prosecution and not to acquiesce to the rejection, Applicant has amended the claims to remove the "variants" language thereby obviating this rejection. As such the cited prior art no longer reads on the claimed invention.

For these reasons, the above anticipation rejection should be withdrawn.

VII. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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APPENDIX:

The Appendix includes the following item(s):

- clean version of the revised Abstract